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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,520	12/30/2003	Irene Spitsberg	129968	7282
49305	7590	12/12/2005	EXAMINER	
JAGTIANI + GUTTAG 10363-A DEMOCRACY LANE FAIRFAX, VA 22030			MCNEIL, JENNIFER C	
			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 12/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,520

Applicant(s)

SPITSBERG ET AL.

Examiner

Jennifer C. McNeil

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4-12, 14-18, and 21-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Bruce (US 20030224200 A1). Bruce teaches a thermal barrier coating material for turbine engine components. The coating material comprises zirconia stabilized with yttria, and one or more of lanthana, neodymia, or tantalum. Regarding claim 3, the first oxide is considered yttria, which may be added in an amount of up to about 10 wt%, and the second oxide is lanthana, which may be added in an amount of up to about 5 wt%. Bruce also includes a bond coating between the substrate and the thermal barrier. The thermal barrier may have a thickness of about 75-300 microns.

A composition comprising 90 wt% zirconia, 7 wt% yttria, and 1.2 wt% lanthana corresponds to 94.8 mol% zirconia, 4 mol% yttria, and 3 mol% lanthana. Please see the attached conversion chart.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 2, 4-12, and 14-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce (US 2003/0224200 A1). Bruce teaches a thermal barrier coating as discussed above, but does not give additional thicknesses for the thermal barrier coating. While Bruce does not give specific examples falling within the claimed range, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Bruce overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Bruce teaches that the thickness should be sufficient to provide the required thermal protection for the underlying substrate. While Bruce gives one example of a thickness, one of ordinary skill in the art would recognize that a thicker coating would provide increased thermal resistance.

Response to Arguments

Applicant has argued that Bruce does not teach a composition overlapping with the claimed ranges. Applicant's attention is drawn to paragraphs 0017 and 0023 of Bruce wherein Bruce states that an acceptable composition is YSZ containing about one up to about ten weight percent yttria, and about 0.1 to about 4 wt% lanthana. The previous office action had a conversion chart attached, which was referenced in the office action. The rejection misstated that the conversion of lanthana at 3 wt% would be 3 mol%, however, the chart clearly shows that the conversion of 90 wt% ZrO₂, 7 wt% Y₂O₃, and 3 wt%

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La_2O_3 corresponds to 94.8 mol% ZrO_2 , 4 mol% Y_2O_3 , and 1.2 mol% La_2O_3 . This clearly shows that the ranges taught by Bruce fall within the ranges of the claims. Bruce repeatedly gives 7wt% (4 mol%) as an example of the amount of yttria added. Bruce teaches an amount of up to 5 wt% lanthana, and the values of 2 and 3 wt% of lanthana convert to 0.8 and 1.2 mol% respectively (see attached charts) (with equal amounts of yttria (7 wt%) added). Furthermore, 88 wt% ZrO_2 , 7 wt% Y_2O_3 , and 5 wt% La_2O_3 corresponds to 94 mol% ZrO_2 , 4 mol% Y_2O_3 , and 2 mol% La_2O_3 , which shows that the endpoints of the ranges for lanthana overlap (see chart).

For at least these reasons, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer C. McNeil whose telephone number is 571-272-1540. The examiner can normally be reached on 9AM-6PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer C McNeil
Primary Examiner
Art Unit 1775

JCM